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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,882	01/26/2001	James D. Hempleman	PRE2519P0011US	6661

7590 05/07/2003

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CHICAGO, IL 60606

EXAMINER
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KINDRED, ALFORD W

ART UNIT	PAPER NUMBER
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2172

DATE MAILED: 05/07/2003

*Handwritten signature*

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/770,882

Applicant(s)

HEMPLEMAN ET AL.

Examiner

Alford W. Kindred

Art Unit

2172

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 February 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 30-119 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 30-58 is/are allowed.
- 6) ☒ Claim(s) 58-61,63,64,67-71,74-83,89-96,99-110,113-116,118 and 119 is/are rejected.
- 7) ☒ Claim(s) 62,65,72,73,84-88,97,98,111 and 112 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

1. This action is responsive to communication: RCE. filed on 02/14/2003.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 58—61 and 63-64 are rejected under 35 U.S.C. 102(e) as being anticipated by Allison, US# 5,668,788.

As per claim 58, Allison teaches “accessing at least one source of works . . . creating at least one play list . . .” (see col. 3, lines 35-67) “play list and for maintaining popularity information pertaining to works from . . . play list” (see col. 3, lines 1-28).

As per claim 59, Allison teaches “obtaining works not locally . . .” (see col. 2, lines 48-67, whereas Allison’s computer element includes the communication means to obtain data remotely, as taught in applicant’s claim language).

As per claim 60, Allison teaches “presenting advertisements” (see col. 3, lines 7-25).

As per claim 61, Allison teaches “works selected in accordance with a pre-established criterion” (see col. 2, lines 14-40).

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***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 67-71, 74-83, 89-96, 99-110, 113-116, and 118-119 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allison, in view of Janky, US# 5,914,941.

As per claims 67-71, 75-77 and 89, Allison teaches "a user station for creating at least one list of multiple works" (see col. 2, lines 53-67). Allison does not explicitly teach "at least in part at the user station for downloading at least some of the works on the list . . .". Janky teaches "at least in part at the user station for downloading at least some of the works on the list . . ." (see col. 11, lines 3-24). It would have been obvious at the time of the invention for one of ordinary skill in the art to have combined the teachings of Allison and Janky because using the steps of "at least in part at the user station for downloading at least some of the works on the list . . ." would have given those skilled in the art the tools to transfer data from a centralized source to a target source via a network. This gives users the advantage of retrieving, using and/or manipulating data from various remote sources.

As per claims 74 and 80, Allison teaches "the user station graphically displays simultaneously at least some of an invention of available works . . ." (see col. 2, lines 53-67).

As per claims 78-79, Allison teaches "controlling a media writing device, coupled . . . a removable medium . . ." (see col. 2, lines 20-35, whereas Allison's computer contains a hard drive that is capable of being removed with the data intact, as illustrated in applicant's claim language.

As per claims 81-83, these claims are rejected on grounds corresponding to the arguments given above for rejected claim 74 and are similarly rejected including the following:

--Allison teaches "the list include advertisement" (see col. 1, lines 60-67).

As per claims 90-91, Allison teaches "list comprise video . . ." (see col. 1, lines 35-63).

As per claims 92-96, 99-100, 104-110, 113-116 and 118, these claims are rejected on grounds corresponding to the arguments given above for rejected claims 58-61 and 67-70 and are similarly rejected.

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 30-119 have been considered but are moot in view of the new ground(s) of rejection.

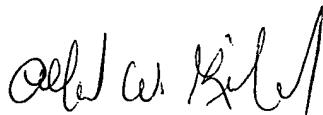
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**Conclusion**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alford W. Kindred whose telephone number is 703-305-3802. The examiner can normally be reached on Mon-Friday, 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 703-305-4393. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



Alford W. Kindred  
Patent Examiner  
Tech Ctr. 2100  
April 30, 2003